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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,259	04/29/2005	Yuntae Kim	21186YP	7180
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MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER				
STOCKTON, LAURA LYNNE				
ART UNIT		PAPER NUMBER		
1626				
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03/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,259

**Applicant(s)**

KIM ET AL.

**Examiner**

Laura L. Stockton

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-8,11,12,25-27,32,33,36,37 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-42 is/are allowed.
- 6) ☒ Claim(s) 1.5-8,25,32,33 and 43 is/are rejected.
- 7) ☒ Claim(s) 11,12,26,27,36 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/5/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

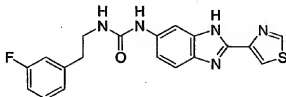
**Claims 1, 5-8, 11, 12, 25-27, 32, 33, 36, 37 and 40-43 are pending in the application.**

***Election/Restrictions***

Applicant's election without traverse of Group II (claims 1-9, 11, 12, 25-27, 32, 33, 36, 37 and 40-42 - drawn to compounds of formula (I) wherein R<sup>1</sup> is thiazolyl; and R<sup>2</sup> is -C(=O)NR<sup>5</sup>R<sup>6</sup>), and the species of Example 3 found on page 69 of the instant specification (reproduced below), in the reply filed on April 21, 2008 was acknowledged in the previous Office Action.

**EXAMPLE 3**

**1-[2-(3-Fluoro-phenyl)-ethyl]-3-(2-thiazol-4-yl-3H-benzimidazol-5-yl)-urea (2-77)**



**2-77**

The requirement was deemed proper and therefore made FINAL in the previous Office Action.

Subject matter not embraced by elected Group II is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 21, 2008.

***Information Disclosure Statement***

The Examiner has considered the Information Disclosure Statement filed on December 5, 2008.

Rejections made in the previous Office Action that do not appear below have been overcome by Applicant's

amendments to the claims. Therefore, arguments pertaining to these rejections will not be addressed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-8, 25, 32, 33 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoff et al. {U.S. Pat. 3,743,738}.

Hoff et al. disclose a compound such as Example 60 in column 25 which is embraced by the instant currently amended claimed invention. Therefore, Hoff et al. anticipate the instant claimed invention.

***Response to Arguments***

Applicant's arguments filed August 6, 2008 have been fully considered. Applicant argues that the current amendments to the claims render moot the rejection of the claims under 35 USC 102(b). In response, it is disagreed that the rejection of the claims under 35 USC 102(b) as being anticipated by Hoff et al. has been overcome. Compound 60 (column 25) in Hoff et al. is embraced by current amended claim 1 when R<sup>1</sup> is an unsubstituted thiazolyl; R<sup>2</sup> is -C(O)NR<sup>5</sup>R<sup>6</sup>; R<sup>5</sup> and R<sup>6</sup> taken together with the nitrogen to which they are attached to form a monocyclic 5-membered ring; and R<sup>3</sup> is hydrogen. The rejection is deemed proper and therefore, the rejection is maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-8, 25, 32, 33 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoff et al. {U.S. Pat. 3,743,738}.

***Determination of the scope and content of the prior art (MPEP §2141.01)***

Applicant claims benzimidazole compounds. Hoff et al. (see entire document; particularly columns 2-4, 14 and 15; and especially Example 60 in column 25) teach benzimidazole compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds.

***Ascertainment of the difference between the prior art and the claims  
(MPEP §2141.02)***

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

***Finding of prima facie obviousness--rational and motivation (MPEP  
§2142-2413)***

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., anthelmintics).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful as anthelmintic agents. The instant claimed



invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

***Response to Arguments***

Applicant's arguments filed August 6, 2008 have been fully considered. Applicant argues that: (1) the citation of *In re Lemin* is inappropriate; and (2) the compounds of Hoff et al. are not the same as the instant claimed compounds. In response, Hoff et al. disclose compounds that anticipate the instant currently amended claims and therefore, some of the compounds of Hoff et al. are no different than the instant claimed compounds. Further, it is disagreed that the citation of *In re Lemin* is inappropriate. Some of the instant claimed compounds are generically taught in Hoff et al. and by the picking and choosing in Hoff et al., one skilled in the art would arrive at

the instant claimed compounds. Therefore, Applicant's argument is not persuasive.

Applicant argues that the instant claimed compounds have a different utility than the compounds of Hoff et al. In response, there is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. In re Dillon, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990).

Applicant argues that Official Judicial Notice should be taken since evidentiary support is needed to prove that the compounds of the instant claimed invention are obvious as anthelmintics. In response, it is disagreed that Official Judicial Notice should be taken. Products, not methods of use, are under examination in the instant application. As stated above, there is no requirement that the prior art must suggest that the claimed product will have the same or

similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. In re Dillon, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990). Therefore, Applicant's argument is not persuasive.

Applicant argues that the R<sup>4</sup> variable in Hoff et al. can be **un**substituted monoloweralkylamino, diloweralkylamino or cycloalkylamino. In response, Hoff et al. disclose compounds which anticipate the current amended claims (see above 102 rejection) as well as teach compounds in which the current amended claims are obvious (see above 103 rejection). For all the reasons stated above, the rejection is deemed proper and therefore, the rejection is maintained.

### ***Allowable Subject Matter***

The elected species of Example 3, found on page 69 of the instant specification, is allowable over the art of record.

Claims 11, 12, 26, 27, 36 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 40-42 are allowed over the art of record.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed

until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact

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the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/

Laura L. Stockton

Primary Examiner, Art Unit 1626

Work Group 1620

Technology Center 1600

March 18, 2009